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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,558	11/17/2000	William J. Jones	A-68747/JGW	6528
7590	03/04/2004			
FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP Suite 3400, Four Embarcadero Center San Francisco, CA 94111			EXAMINER MCLOUGHLIN, MICHAEL I	
			ART UNIT 2662	PAPER NUMBER

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,558

Applicant(s)

JONES ET AL.

Examiner

Michael I McLoughlin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the following as described in the specification:

- VSIM' in the new PC in figure 2 as described on line 29 of page 6.
- New PC 21 as described in line 28 of page 6 is not shown in figure 2 for the new PC is "27" and not -21-.

Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters UE and U/ (left of ~22 in figure 1) have both been used to designate UE. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:

- a) In lines 6-7 of page it states "RADIUS server authentication server" that reads awkwardly. Perhaps - RADIUS authentication server- might be better.
- b) In line 23 it states "access network operator 33", which might be better phrased as 'access network 33 operator'.

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- c) In line 24 of page 6 it states, "indicated as 21 in figure", and the figure number is missing. This could be -figure 1- in the present drawings, or could be figure 2 if the new PC were identified as -21- instead of "27" as cited above.
- d) In line 29 of page 6 " VISIM' " is probably a typographical error and probably should be -VSIM'-.
- e) In line 2 of page 7 it states, "original or old UE", but there is no disclosure of a new UE, perhaps -original or old- could be deleted.

Appropriate correction is required.

Claim Objections

4. Claim 1 is objected to because of the following informalities: In line 9 there is an "anonymous connection to said network". However, Examiner notes that this connection is not an "anonymous connection"; rather this connection requires the UE ID and a temporary password, thus, only one known by the network can make this connection and not anyone or an unknown person. Perhaps this could be called an -initial registration connection-.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "the original associated UE" renders the claim indefinite, for what is associated with what?

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xu et al. (U.S. 6,151,628), hereinafter referred to as Xu, in view of Request for Comments: 2604, hereinafter referred to as RFC 2604, and further in view of Ikeda (U.S. 6,490,667).

9. Regarding claim 1, Xu teaches a method of operating a cellular wireless Internet access system as part of an Internet Network (see figure 1, with the wireless network 16 operating as part of Internet Network 22) where users have PCs and each user utilizes a UE with a directly attached antenna for communicating in a wireless manner on a cellular network with an integrated network controller (PC 12 that inherently includes a UE and an antenna for communicating on the wireless network 16 with communications chassis 20) with the network having an access authentication server (access authentication servers 32A, 32B and 46 of figure 1), that performs the following steps:

validating subscriber identity information at the authentication server that includes at least a user ID and password (calling-station ID, see line 60 in column 15; user-name, see line 53 in column 16; and user-password, see line 55 in column 16), and connecting PCs to allowable ISPs with subscriber information (connecting to either ISP#1 or ISP#2 based on the subscriber information see lines 2-7 in column 5).

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Xu teaches operating an existing cellular wireless Internet access system as part of an Internet Network, but fails to teach registration on the network with a registration server, downloading or storing subscriber identity information, or transferring a user ID or password to another PC.

RFC 2604 teaches Over-the-Air where the network includes a registration server (provisioning server as taught in section 4.4 in page 10) that performs the following steps:

using the PC to register with the registration server on the network via an autonomous connection to the network (to perform OATPA via data services the mobile station initiates a special-purpose data call, taught in lines 4-5 of section 43 on page 10, that is established based on the mobile station Electronic Serial Number, or ESN using a limited-time password, taught in lines 2-5 in section 5.1.1, with the provisioning server that is interconnected to the authentication server that both reside in the IP network, taught in section 4.4), downloading the subscriber identity information from the registration server to the PC for storage in the PC (provisioning information immediately available for downloading into the chosen mobile station, taught in lines 14-15 in section 4.4), with the subscriber identity information including a user ID and a permanent password (Mobile Identification Number or MIN taught on page 4, and an A-key taught on page 3), where the stored information constitutes a VSIM (Number Assignment Module, or NAM that is an electronic memory module where MIN and other parameters are stored as taught on page 5), and updating the authentication server (the provisioning server must be capable of receiving dynamic updates from the MTAS implies that the authentication server is updated as taught in lines 12-14 of section 4.4).

RFC 2604 fails to teach transferring the user ID and password to another PC.

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It would have been obvious to one of ordinary skill in the art to modify Xu's network by adding a provisioning server that uses OTASP/ATAPA as taught by RFC 2604 to Xu's network that is interconnected to Xu's authentication servers. One would have been motivated to make this modification to expand Xu's network to not only operate the existing network but also have a capability to add new users to the network where new users are added at a greatly reduced cost by using over-the-air activation mechanisms as opposed to manual parameter provisioning as taught by RFC 2604 in lines 4-7 of the abstract on page 1.

Ikeda teaches electronically transferring a user ID and password to another PC in figure 21 with the memory card M shown as 4 where memory card M stores Internet connection 150 that includes the user ID and password which is transferred to any PC when memory card M is inserted in a slot on the PC and executed as taught in lines 27-30 in column 8.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Xu's method for operating the network by including the use of memory card M in the user PCs of Xu's network. One would have been motivated to make this modification in order to allow subscribers to use PCs other than their original PC on the network without requiring any network intervention and extend flexibility on network access by allowing other PCs to include newly purchased PCs, laptop PCs, or PCs while traveling.

Modifying Xu's method of operating the cellular network with the teachings of RFC 2604 and Ikeda based on the motivation for each teaching would have arrived at the claimed invention.

10. Regarding claim 2 (with best understanding), it is inherent that the UE like other PC peripherals can be disconnected from the original PC and be connected to another PC for its function, which is enabling an Internet session for the UE.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- 1) Ryu U.S. 6453,414), Computer system with PC cards and method of booting the same.
- 2) Hsu et al. (U.S. 6,587,684), Digital wireless telephone system for downloading software to a digital telephone using wireless data link protocol.
- 3) Waugh et al. (U.S. 6,324,402), Integration scheme for a mobile telephone.
- 4) Rosenberg et al. (U.S. 6,628,934), Systems and methods for automatically provisioning wireless services on a wireless device.
- 5) Tiedemann, Jr. et al. (U.S. 6,381,454), Method and system for over-the-air service programming.
- 6) Nodoushani et al. (U.S. 6,144,849), Method and apparatus for over-the-air provisioning of a mobile telephone.
- 7) Larkins (U.S. 6,295,291), Setup of new subscriber radiotelephone service using the Internet.
- 8) Rai (U.S. 6,675,208), Registration scheme for network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael I McLoughlin whose telephone number is 703-308-7911. The examiner can normally be reached on weekdays 7AM - 3:30PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 703-305-4744. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MM

February 26, 2004



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